

#72

Amendment Under 37 CFR §1.116  
EXPEDITED PROCEDURE  
Art Unit 2153

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Jean-Francois Le Pennec et al.

Serial No.: 09/659,649

Filed: September 12, 2000

For: FILE TRANSFERS BETWEEN A  
REMOTE HOME SERVER AND A  
LOCAL SERVER

Attorney Docket No. FR9-1998-0072-US1

Examiner: Kimberly D. Flynn

Art Unit: 2153

RECEIVED  
CENTRAL FAX CENTER

APR 26 2004

OFFICIAL

RESPONSE C UNDER 37 CFR § 1.116

Commissioner for Patents  
Mail Stop: AF  
P.O. Box 1450  
Arlington, Virginia 22313-1450

Sir:

This Response is submitted in reply to the Final Office Action dated February 26, 2004, having a shortened statutory period set to expire May 26, 2004. It is believed that no fee is required by this amendment; however, in the event that any fee may be required, please charge such fee to IBM Corporation Deposit Account Number 09-0457.

CERTIFICATE OF FACSIMILE TRANSMISSION	
37 CFR 1.116	
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office to its Central Facsimile Number (703) 305-2980 to the Attention of Examiner Kimberly D. Flynn, Art Unit 2153 on April 26, 2004.	
Shenice D. Rameen	<i>[Signature]</i>
Type Name of Person Signing	Signature of Person Signing

**INTRODUCTORY COMMENTS**

This Response is submitted in reply to the Final Office Action dated February 26, 2004, having a shortened statutory period set to expire May 26, 2004. Claims 5 and 7 are pending. No claims have been amended.

In Applicants' previous response, we had argued that *Logue* nowhere describes any information regarding a forwarded document or identifying that a file has been forwarded. Further, Applicants' had argued that nothing within *Logue* had described storing information regarding whom a file is forwarded to. As Applicants further argued, *Logue*, and similarly *Katz*, failed to show or suggest maintaining information regarding location and identity of clients holding a copy of the source document.

In the present Office Action, the Examiner has admitted that *Logue* does not "explicitly disclose wherein the information includes information identifying where the file has been forwarded." Nonetheless, the Examiner has argued that such would be obvious in order to keep track of user's access to certain files. Applicants specifically dispute this assumption and respectfully request the Examiner show evidence in the prior art by citing a specific prior art reference disclosing this aspect of the present invention. More specifically, Applicants respectfully request that evidence be put forth by the Examiner disclosing in the prior art a "server further comprises a remotely logged client table for identifying where said file has been forwarded" as is recited in exemplary Claim 5 in the present application or a reference that suggests such a modification to the system of *Logue*. A showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular. . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)." *In re Kotzab*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). The present invention provides a significant advantage of maintaining information regarding the location and identity of clients maintaining a copy of the

sourced document. This mechanism provides coherency between the home server, the remote server and client. Such database information is not maintained in the system disclosed by *Logue*, nor are the advantages of maintaining this information suggested. Consequently, Applicants respectfully submit that the present invention as claimed in Claims 5 and 7 is not shown or suggested in the prior art, and the present rejection should be reconsidered.

Respectfully submitted,



Craig Yudell  
Reg. No. 39,083  
DILLON & YUDELL LLP  
8911 North Capital of Texas Highway  
Suite 2110  
Austin, Texas 78759  
512.343.6116  
ATTORNEY FOR APPLICANT(S)